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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,941	12/06/2000	James M. Allen	226272001403	6840

7590 05/13/2003  
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EXAMINER

WHITEMAN, BRIAN A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/731,941	<b>Applicant(s)</b> ALLEN, JAMES M.	
	<b>Examiner</b> Brian Whiteman	<b>Art Unit</b> 1635	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-7,9-12,14-17,21,22 and 24-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9-12,14-17,21,22,24-34 and 38-41 is/are rejected.
- 7) ☒ Claim(s) 35-37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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## **DETAILED ACTION**

### **Non-Final Rejection**

Claims 1-3, 5-7, 9-12, 14-17, 21, 22, and 24-41 are pending.

Applicant's traversal, the amendment to claims 1, 5, 10, 14, 17, and 21, the cancellation of claims 4, 8, 13 and 23 in paper no. 15 filed on 3/5/03.

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### ***Specification***

The disclosure is objected to because of the following informalities: An accession no. is missing for the cell line submitted to ATCC on page 37, line 5.

The address of ATCC is incorrect on page 37, line 4.

See [http://www.atcc.org/forms/Cell\\_Biology.pdf](http://www.atcc.org/forms/Cell_Biology.pdf) for current address.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

Applicant's arguments, see paper no. 15, filed on 3/5/03, with respect to 112 first paragraph enablement rejection have been fully considered and are persuasive. The rejection of claims 1-17 and 21-23 has been withdrawn because of the amendment to claims 1, 5, 10, 14, 17, and 21 and the cancellation of claims 4, 8, 13 and 23.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1-3, 5-7, 9-12, 14-17, 21, 22, 24-34, and 38-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims read on an AAV cap gene operably to a promoter. The specification provides sufficient description of an AAV cap gene operably to the AAV p40 promoter (the endogenous promoter of the cap gene). See Figure 1 and page 34, line 21. However, in view of claims 35-37, the claims read on operably linking an endogenous promoter or a heterologous promoter to the AAV cap gene. The specification does not provide sufficient description of a heterologous promoter operably linked to the AAV cap gene. The specification disclosed operably linking a virus-inducible promoter to the AAV rep gene. However, the rep gene and cap gene are two different genes that are controlled by different promoters. The specification does not disclose a genus of endogenous or heterologous promoters that are operably linked to the cap gene.

The court in Enzo 188 F.3d at 1374, 52 USPQ2d at 1138 states:

It is well settled that patent applications are not required to disclose every species encompassed by their claims, even in an unpredictable art. However, there must be sufficient disclosure, either through illustrative examples or terminology, to teach those of ordinary skill how to make and use the invention as broadly as it is claimed.

In re Vaeck, 947 F.2d 48, 496 & n.23, 30 USPQ2d 1438, 1445 & n.23 (Fed. Cir. 1991)(citation omitted). Here, however, the teachings set forth in the specification provide no more than a "plan" or "invitation" for those of skill in the art to experiment...; they do not provide sufficient guidance or specificity as to how to execute that plan. See Fiers v. Revel, 984 F.2d 1164, 1171, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993); In re Wright, 999 F.2d...[1557], 1562, 27 USPQ2d...[1510], 1514. [footnote omitted].

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Thus, the specification does not describe the claimed invention in such a way as to reasonably convey to one skilled in the art that inventor, at the time the application was filed, had possession of the claimed invention.

Applicant's arguments with respect to Claims 1-3, 5-7, 9-12, 14-17, 21, 22, 24-34, and 38-41 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 6, 10, 11, 12, 15, 16, 17, 21, 22, 24, 25, 26, 30, 32, 34, and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9, 11, 12, 15, 17, 18, and 21 of U.S. Patent No. 6,541,258. Although the conflicting claims are not identical, they are not patentably distinct from each other because '258 claims a mammalian cells and methods of generating a mammalian cell useful for high efficiency packaging of an rAAV vector comprising stably integrated an AAV rep gene operably linked to a promoter and an AAV cap gene operably linked to a promoter. The definition in the

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specification of '258 for a promoter operably linked to an AAV cap gene embraces a helper virus inducible heterologous promoter (column 22, lines 1-24).

Applicant's arguments with respect to claims 1, 2, 6, 10, 11, 12, 15, 16, 17, 21, 22, 24, 25, 26, 30, 32, 34, and 40 have been considered but are moot in view of the new ground(s) of rejection.

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### ***Conclusion***

Claims 35-37 are objected to as being dependent upon a rejected base claim (claims 1, 36 and 37), but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Whiteman whose telephone number is (703) 305-0775.

The examiner can normally be reached on Monday through Friday from 7:00 to 4:00 (Eastern Standard Time), with alternating Fridays off.

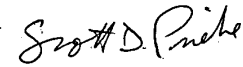
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader, SPE - Art Unit 1635, can be reached at (703) 308-0447.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Brian Whiteman  
Patent Examiner, Group 1635



SCOTT D. PRIEBE, PH.D.  
PRIMARY EXAMINER

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